

UNITED STATES DISTRICT COURT
DISTRICT OF PUERTO RICO

ASOCIACIÓN DE INDUSTRIALES
DE PUERTO RICO,

Plaintiff,

v.

MARKETNEXT, INC., et al.,

Defendants.

Civil No. 09-1122 (JAF)

O R D E R

On March 27, 2009, Plaintiff moved to compel Defendants' compliance with our preliminary injunction in this case. Docket No. 64. On March 11, 2009, we entered an Order ("Order") against Defendants, preliminarily enjoining them from (1) using the mark, "Industriales," in commerce via print or electronic media, (2) causing the public to associate Defendants' services with Plaintiff, and (3) competing unfairly with Plaintiff or its licensees by falsely representing the nature of Defendants' services. Docket No. 46. We further required Defendants to "communicate this Order to . . . persons in active concert or participation in the publication of Defendants' magazine, and each and every person using the mark INDUSTRIALES, selling advertisement in Defendants' magazine, advertising in Defendants' magazine . . . and to any other person that may have a legal or economic interest in Defendants' magazine."

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1 Id. (emphasis added). We allowed Defendants ten days to certify by
2 sworn affidavit their compliance with the Order. Id. On March 23,
3 2009, we issued a memorandum opinion supporting and reiterating our
4 Order. Docket No. 58.

5 On March 23, 2009, Defendants submitted a motion in compliance
6 with an affidavit from Defendant Edison Mislá-Grillasca ("Mislá").
7 Docket No. 60. Mislá attests that Defendants sent a letter to their
8 subscribers, clients, and vendors, informing the addressees that
9 Defendants' publication had altered its name to "Empresarios." Id.
10 Mislá contends that Defendants have sufficiently complied with our
11 Order by adopting a new title and ceasing to use the mark,
12 "Industriales," the domain name, "industrialesmag.com," and the
13 internet address, "www.industrialesmag.com." Id.

14 Plaintiff notes, however, that Defendants have failed to
15 "communicate [the] Order," per our mandate. Docket No. 64. This
16 omission creates a false impression of continuity between Defendants'
17 former publication under their agency relationship with Plaintiff and
18 their present publication, which is no longer authorized by
19 Plaintiff. Id.

20 Our Order related not only to Defendants' ongoing trademark
21 infringement, but also to their unfair competition with Plaintiff,
22 their former principal. See Docket Nos. 46, 58. By our requirement
23 for Defendants to communicate the substance of the Order to all
24 persons with "legal or economic interest in Defendants' magazine," we

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1 intended to resolve lingering doubt in the public as to the true
2 identity and nature of Defendants' publication in relation to
3 Plaintiff's authorized publications. See id. A half-hearted circular
4 letter that omits any reference to our Order cannot serve.

5 In addition to Defendants' communication of our preliminary
6 injunction to their business contacts, Plaintiff requests further
7 clarification that Defendants' magazine bears no relation to their
8 previous publication on behalf of Plaintiff. Docket No. 64. To
9 resolve public confusion, the court may fashion equitable remedies
10 that "enjoin only those uses that are likely to create appreciable
11 confusion, and no more." Joseph Scott Co. v. Scott Swimming Pools,
12 Inc., 764 F.2d 62, 67 (2d Cir. 1985). To this end, we may use
13 disclaimers to distinguish competing products and preserve the rights
14 of the trademark holder. L. E. Waterman Co. v. Modern Pen Co., 235
15 U.S. 88 (1914). In view of Defendants' continuing evasion of justice,
16 we command them to print a conspicuous and unambiguous notice in
17 their forthcoming publication disclaiming all connection to Plaintiff
18 and its authorized magazine, "Industriales."

19 Accordingly, we hereby **GRANT** Plaintiff's motion to compel
20 compliance, Docket No. 64. It is hereby:

21 **ORDERED**, that Defendants distribute the text of our Order,
22 Docket No. 46, and our memorandum opinion, Docket No. 58, in full to
23 all their subscribers, clients, and vendors, including all persons

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1 who have purchased advertisements in Defendants' magazine, and any
2 other person with legal or economic interest in their publication;

3 **ORDERED**, that Defendants faithfully reproduce the following
4 notice in bold, all capital letters, single-space, and monospace
5 Courier font no smaller than one pica (twelve-point), in both English
6 and Spanish, on the second or third page of each copy of their issues
7 of "Empresarios" for the term of one (1) year:

8 (1) "EMPRESARIOS" IS NOT RELATED TO "INDUSTRIALES" MAGAZINE IN
9 ANY WAY, AND IS NOT A CONTINUATION, SUCCESSOR, OR MODIFICATION
10 OF "INDUSTRIALES";

11 (2) MARKETNEXT, INC. NO LONGER PUBLISHES "INDUSTRIALES" FOR THE
12 PUERTO RICO MANUFACTURERS' ASSOCIATION (PRMA) AND "EMPRESARIOS"
13 IS NOT AN AUTHORIZED PUBLICATION OF THE PRMA;

14 and

15 **ORDERED**, that Defendants certify by sworn affidavit their
16 compliance with the present order **by not later than April 13, 2009.**

17 **IT IS SO ORDERED.**

18 San Juan, Puerto Rico, this 31st day of March, 2009.

19 s/José Antonio Fusté
20 JOSE ANTONIO FUSTE
21 Chief U.S. District Judge